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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/738,659 10/30/96 MOTOYAMA

T 5244-051-2X-
EXAMINER

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ART UNIT 111 PAPER NUMBER

DATE MAILED: 2756

11/25/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 09/21/98

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10, 12-19, 36, 38-44, 52-61 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10, 12-19, 36, 38-44, 52-61 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Summary, PTO-413

☐ Drawing Review, PTO-948

1. The objection to the specification and the rejections of claims 10, 12-15, 19, 36, 38-41, 45, 52-61, and 65-67 are rejected under 35 U.S.C. 112, first paragraph have been withdrawn due to applicant's amendment filed on 09/21/98.

2. Claims 10, 12-19, 36, 38-44, and 52-61 are presented for examination.

3. Claims 10, 12-19, 36, 38-44, and 52-61 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Cohn et al (Cohn)** patent no. **5,740,231**.

4. As to claim 10, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a monitored device and a monitoring device (printer 4 and NTWK ADMIN PC 14, figure 1) comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35); and

transmitting the information as an message from the monitoring device to the monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, or video transmission capabilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's monitored and monitoring devices because it would allow message to be transferred globally between any devices.

5. As to claims 12-13, Kraslavsky teaches transmitting a message to the monitored device which is a business office device such as copier, facsimile machine, or printer (Abstract, and col. 2 lines 35-62).

6. As to claim 14, Kraslavsky and Cohn teach receiving the transmitted information by the monitored device; and transmitting an Internet electronic mail message from the monitored device to the monitoring device containing status information of the monitored device, in response to the transmitted information from the monitoring device (Kraslavsky, col. 2 lines 35-62; Cohn, col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36).

7. As to claim 15, Kraslavsky teaches transmitting the information from the monitoring device to a plurality of monitored devices including the monitored device (col. 34 lines 63-67).

8. As to claim 16, Kraslavsky teaches the invention substantially as claimed, including a method for communicating between a machine and a monitoring device, comprising the steps of:

determining status information using at least one of a mechanical and electrical sensor (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35); and

transmitting the status information from the machine to the monitoring device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, or video transmission capabilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's machine and monitoring

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device because it would allow message to be transferred globally between any machine and device.

9. As to claim 17, Kraslavsky and Cohn teach analyzing the status information by the machine, wherein the status information is transmitted as the Internet electronic mail message from the machine when the status information is analyzed and determined to be within a standard operating range (Kraslavsky, col. 39 lines 20-54; col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36).

10. As to claim 18, Kraslavsky and Cohn teach determining status information which is outside of normal operating parameters exists in the machine using at least one of the mechanical and electrical sensor; and transmitting a connection-mode message from the machine to the monitoring device containing the status information which is outside of the normal operating parameters (Kraslavsky, col. 39 lines 20-54; col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36).

11. As to claims 52-53, Cohn inherently teaches Internet electronic mail message includes an "@" symbol followed by a domain name, and a description of an encoding type of the Internet electronic mail message. This information is also admitted by applicant as well known.

12. As to claim 54, Kraslavsky and Cohn teach the invention substantially as claimed as discussed above; however, they do not explicitly teach using a firewall. Official Notice is taken that firewall is well known in Data Processing Art. It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to use a firewall in Kraslavsky and Cohn's network because it would not allow communication between the monitor device and the machine if message do not satisfy filter conditions in the firewall.

13. Claims 19, 36, 38-44, and 55-61 have similar limitations as claims 10-18 and 52-54; therefore, they are rejected under the same rationale.

14. In the remarks, applicant argued in substance that

(A) Prior art does not teach transmitting information obtained from sensors of monitored device as an electronic mail message over the Internet;

As to point (A), Kraslavsky teaches CPSOCKET receives status information from a printer and directs the information back to CPCONSOL. Kraslavsky inherently teaches the status information from the printer is obtained from sensors of the printer (col. 39 lines 9-20, and Table 10 begins on col. 41 line 35; Applicant's representative can refer to Banno patent no. 4,876,606 if more explanation is needed regarding to inherent features of the printer); and

transmitting the information as an message from the monitoring device to the monitored device through a Wide Area Network (col. 7 lines 38-63).

However, Kraslavsky does not explicitly teach the message is an Internet electronic mail message.

Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, or video transmission capabilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36).

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's machine and monitoring device because it would allow message to be transferred globally between any machine and device.

(B) Examiner was erroneously indicated Kraslavsky teaches transmitting an Internet electronic mail message.

As to point (B), Examiner's Office Action dated 07/20/98 stated that

I. Claims 10, 12-15, 19, 36, 38-41, 45, 52-61, and 65-67 were rejected under 35 U.S.C. 112, first paragraph. No prior art reference was applied in rejecting claims 10, 12-15, 19, 36, 38-41, 45, 52-61, and 65-67.

ii. Claims 16-18, and 42-44 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over **Kraslavsky et al (Kraslavsky)** patent no. **5,537,626**, in view of **Johnson et al (Johnson)** patent no. **5,414,707**. Kraslavsky and Johnson were cited

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as prior art in the last office action. The rejections for claims 16-18 and 42-44 are respectfully maintained and incorporated by reference as set forth in the last office action. Claims 16-18, and 42-44 did not claim any Internet electronic mail message prior to Office Action dated 07/20/98. Applicant just introduced the "Internet electronic mail message" to limitation of claims 16-18 and 42-44 in Amendment filed on 09/21/98 after the Office Action dated on 07/20/98. There is nowhere in Office Action dated 07/20/98, Examiner stated that Kraslavsky teaches transmitting an Internet electronic mail message in rejecting claims 16-18, and 42-44.

(C) One of ordinary skill in the art would never combine Kraslavsky and Cohn;

As to point (C), Kraslavsky teaches intelligent peripherals (machine) can provide peripheral status data to computers (monitoring device) through a network (col. 9 lines 10-20, and figure 1), and Cohn teaches various source and destination message systems that comprise voice mail, electronic mail, facsimile transmission, or video transmission capabilities that can communicate message to each others using Internet electronic mail message format (col. 8 lines 36-65, and col. 15 lines 65 - col. 16 line 36). It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of Kraslavsky and Cohn to use Internet electronic mail message to communicate between Kraslavsky's machine and monitoring device because it would allow message to be transferred globally between any machine and device. This motivation was given in Office Action dated 07/20/98.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Le H. Luu, whose telephone number is (703) 305-9650. The examiner can normally be reached Monday through Friday from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank J. Asta, can be reached at (703) 305-3817.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

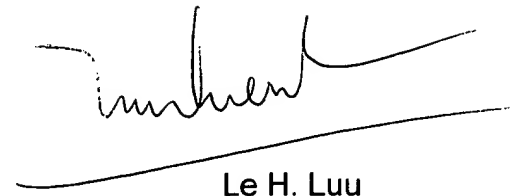
Or:

(703) 308-5359 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington. VA., Sixth Floor (Receptionist).

A handwritten signature in black ink, appearing to read 'Le H. Luu', is written over a horizontal line.

Le H. Luu

Primary Examiner

November 18, 1998